

*** * REASONS FOR AMENDMENTS AND REMARKS * ***

Applicants wish to acknowledge with appreciation the Examiner's analysis and efforts in examining this application.

The amendments made herein were done so for the purposes of placing the application in condition for allowance and/or reducing the outstanding issues for an appeal. In fact, all of the amendments were made pursuant the Examiner's request to do so. Accordingly, it is respectfully requested that this amendment be entered.

I. THE DRAWINGS

On pages 5-7, the Examiner introduced several objections to the drawings. Accompanying this response are replacement sheets that should now moot those objections. Accordingly, it is respectfully requested that the objections be withdrawn. In addition, amendments were made to the specification to maintain consistency between the drawings and the specification.

It is also respectfully requested that in the future, the Examiner address such objections in the first Office Action, rather than waiting until the third and final Office Action to introduce such objections. This would be helpful, especially since the Examiner intends to refuse holding the objections in abeyance until the application is in condition for allowance.

II. THE SPECIFICATION

On pages 7 and 8 of the Office Action, the Examiner objected to portions of the specification based on minor informalities. In response, the specification has been amended to address and resolve those objections. Accordingly, it is respectfully requested that these objections be withdrawn. And, again, it is respectfully requested that in the future these

objections be raised more timely in the first Office Action, rather than waiting until the third. This is especially the case when, as here, the objections are being made against text that appeared in the application as originally filed, not predicated on an amendment made in a previous Office Action Response.

III. CLAIM OBJECTIONS

On page 8 of the Office Action the Examiner objected to Claims 3 and 19 based on minor informalities. In response, appropriate amendments were made to both claims. Accordingly, it is respectfully requested that these objections be withdrawn.

IV. CLAIM REJECTIONS

In addition to entering this amendment, reconsideration of the claim rejections is respectfully requested. The Office Action rejected Claims 1, 3-13, and 15-19 based on either 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a). As discussed henceforth, it is believed that the claims are allowable and in light of the arguments it is respectfully requested that the rejections be withdrawn and the application allowed.

Because it is believed that the substantive rejections are in error, a Notice of Appeal will be filed subsequent to this response. Furthermore, a Request for Pre-Appeal Brief Conference, to possibly resolve this matter as expeditiously as possible, will be filed as well.

A. Claims 8, 11, 13 and 16 are not anticipated by the Sinanan Patent.

On pages 9-10 of the Official Action, the Examiner rejected Claims 8, 11, 13, and 16 under 35 U.S.C. § 102(b) as being anticipated by Sinanan (U.S. Patent No. 5,852,895).

As to Claim 8, the Examiner alleges that Sinanan discloses a landscaping channel liner apparatus (see Fig. 6) that comprises a longitudinally-extending trough 61 having a longitudinally-extending floor located between opposed longitudinally-extending sidewalls

extending therefrom, and having first and second opposed transverse open ends formed from the floor and sidewalls; wherein each of the sidewalls defines a longitudinally-extending edge located opposite the longitudinally-extending floor; a receptacle 63 located on each of the longitudinally-extending edges; a connector 65 engaged with the receptacle 63, extending therefrom, and spaced apart from and positioned substantially parallel to the longitudinally-extending edge; and a selectively removable portion configured to receive a post.

With respect to the limitation of “a selectively removable portion configured to receive a post” the Examiner identifies it as a “broad recitation.” The Examiner alleges that Sinanan has a “selectively removable portion configured to receive a post” because a hole could be cut out of the bottom of the planter in order to receive a post. Therefore, the Examiner concludes that “as broadly recited, Sinanan is deemed to meet this recitation.”

i. The legal standard for rejection under 35 U.S.C. 102 (b)

In order for a prior art reference to anticipate a claim, it *must teach every element of that claim*. See MPEP § 2131 (emphasis added). The law is clear in this regard that “[a] claim is anticipated only if *each and every element as set forth in the claim is found*, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

ii. Sinanan does not teach or disclose a “landscaping channel liner apparatus”

On page 9 of the Office Action, the Examiner alleges that Sinanan discloses a “landscaping channel liner apparatus” such as that shown in Fig. 6. No basis for making this assertion, contrary to MPEP § 707.07 and 2131 is provided, however. Regardless, as best understood, it is respectfully asserted that the Examiner’s allegation is contrary to established law under any analysis.

The Examiner's allegation appears to ignore that the claimed "landscaping channel liner" apparatus is a term of art as used in the specification and not merely a recitation of intended use. Established law requires the Examiner to review "the entirety of the [record] to gain an understanding of what the inventors actually intended and intended to encompass by the claim." *Corning Glass Works v. Sumitomo Elec. USA, Inc.*, 868 F. 2nd 1251, 1257, (Fed. Cir. 1989), MPEP § 2111.02. Moreover, on January 30 of this year the Federal Circuit mandated that Patent Examiners construe claims in light of the specification as established by *Phillips v. AWH Industries*, 415 F.3d 1303 (Fed Cir. 2005). See *In Re Johnston*, No. 05-1321 (Fed. Cir. Jan. 30, 2006).¹

The Patent Office recognizes terms of art to be "an expression or phrase that has a defined meaning when used in a particular context or knowledge environment."
<http://www.uspto.gov/main/glossary/#t>. The term of art used here is a "landscaping channel liner" which like "computers" and "receivers" is language that has a defined meaning when used in a particular context. The word "computer" is an inherently functional word defined as making a mathematical calculation. Clearly within in the context of modern day, however, a "computer" is a device, and not a function. Similarly, the landscaping channel liner in the present application is not intended to be a mere recitation of function, but is a term of art. For example, the specification discusses landscaping channel liners in the following way:

Conventional landscaping channel liners are . . . placed below the ground surface for lining a trench or culvert. Often the channel liners are formed in sections that are combinable to create an extended channel liner of any desired length.²

¹ This holding is believed not inconsistent with longstanding patent office procedure in MPEP § 2111 that requires "the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.'" (emphasis added.)

² Recitation of this text is not intended to import limitations into the claim. Rather, the text is intended to demonstrate how the specification should be used to determine how the claim should be reasonably interpreted.

(Specification at 2, lns. 15-18) “Landscape channel liners” are identified as the subject of these sentences and of the specification. The Examiner does not have license to apply any interpretation, simply a broad interpretation, or even an interpretation that is reasonable to the Examiner. Rather, the Examiner is bound to making a reasonable interpretation that maintains consistency with the specification. See MPEP § 2111, see also *In Re Johnston*, No. 05-1321 (Fed. Cir. Jan. 30, 2006). And in this case the specification identifies landscaping channel liners as a term of art that the Examiner should apply³. In any event, the Examiner’s analysis does not identify how the phrase landscape channel liner is being interpreted. Rather, only a conclusory statement identifying the “raised planter” landscaping channel liner is asserted.

Looking at the prior art cited against the claims, it is easy to distinguish landscaping structures from non-landscaping structures. For example, the Reum et al. reference, despite several clear distinctions, is, at least, directed to a “landscape” structure. Landscape edging is now commonly used to divide different landscape areas preventing foliage of one area from growing into another area. For example, landscape edging is effectively used as a divider between a grassy lawn and a flower bed to prevent the grass from taking root in the flower bed, and also to prevent bedding material in the flower bed from spilling into the grass. (See col. 1, lns. 7-13 of Ruen et al.)

Landscape structures believed possibly relevant to this examination are those that are inserted into the ground to separate one area from another.

The amendments and arguments made herein should not preclude reasonable equivalents.

³ It is noteworthy that even in light of the discussion of the “landscaping channel liner apparatus” contained in this specification, the Applicant is not required to offer an exhaustive recitation on the definition of such structures. See *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) (The patent specification need not teach, and preferably omits, what is well known in the art.) See also MPEP § 2182.

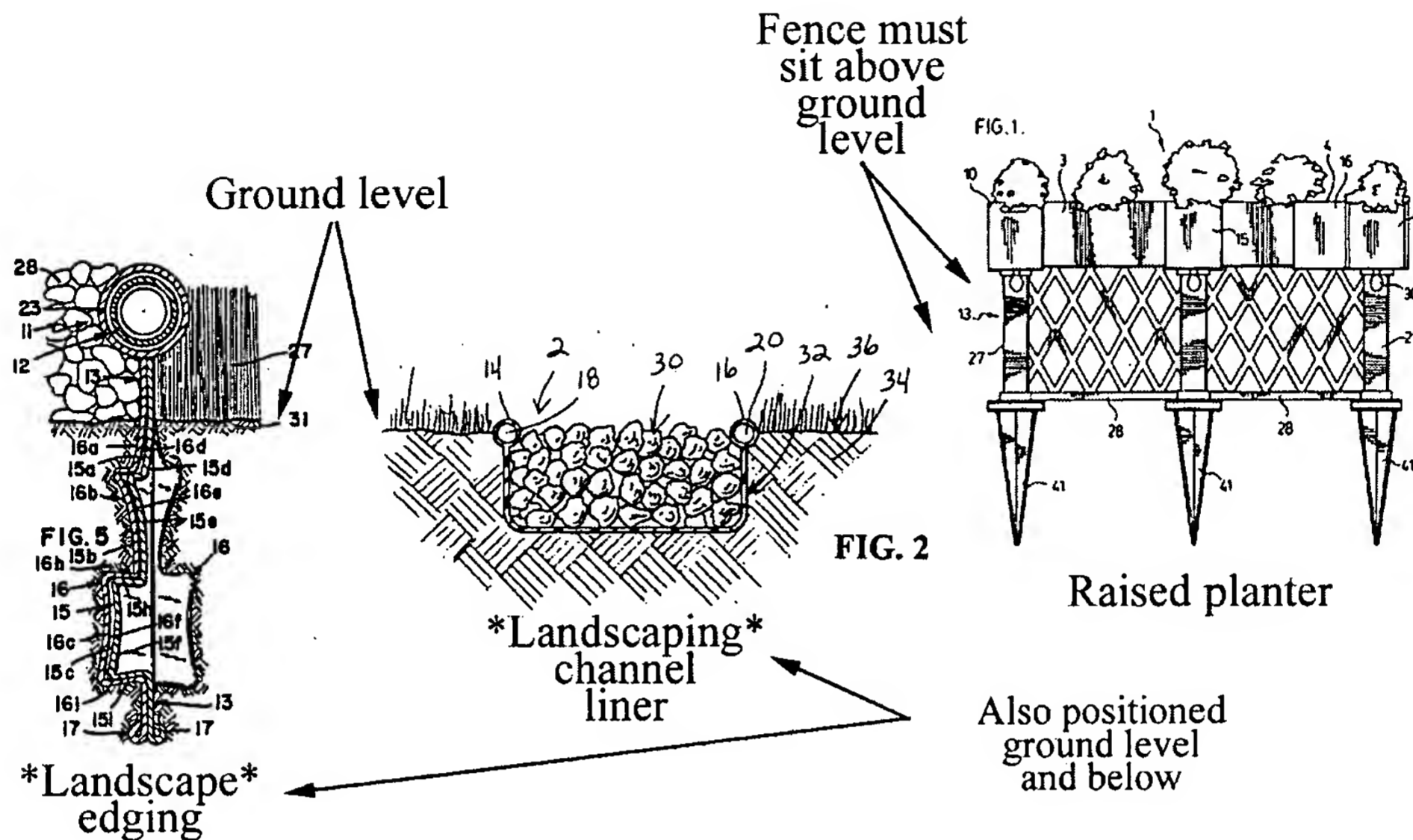


Illustration 1: The **landscape edging** of Reum et al. (*left*) is located in the ground as is the **landscaping channel liner** (*center*). Sinanan (*right*), in contrast, does not line any structure in the ground, and in fact, is required to be located above ground level.⁴

As shown above, structures related to “landscaping” are those inserted into the ground. Again, the function of such landscaping structures is to separate landscaping areas. Structures that do not separate landscaping areas are clearly different and not relevant, such as Sinanan. Sinanan doesn’t separate areas of ground. Sinanan is specifically positioned above the ground.

If the Examiner believes that the “landscaping channel liner apparatus” simply recites an intended use, it is still respectfully asserted that the “raised planter” of Sinanan does not disclose nor perform the same function. As shown above, the function of the “raised planter” provides planter boxes that sit above the ground. In contrast, and as also shown above, the

⁴ The annotations to the drawings throughout this response include large arrowed lines with corresponding text. If the Examiner has any confusion as to what portions of the drawings are annotations and which are original markings, the original drawings should be consulted. In addition, including the drawings and the annotations should not be construed as either limiting the claims to a particular illustrated embodiment or attempt to incorporate the specification into the claims. Rather, the drawings are provided to demonstrate how the claims should be interpreted in light of the specification as required by MPEP § 2111.

claimed landscaping channel apparatus is intended to line a landscaping channel, i.e. line a channel in the ground. Clearly a structure that must be suspended exclusively above ground cannot line a landscaping channel in the ground. Thus, the “raised planter” is not capable of lining a landscaping channel, and thus, is not capable of performing the intended use recited in the preamble, making Sinanan not a “landscaping channel lining apparatus.” (See In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997), see also MPEP § 2111.02.)

When viewing the phrase “landscaping channel liner” in the context of a term of art, it should not be ignored, nor merely dismissed as functional language. Curiously, it is not understood why the Examiner does not welcome such drafting in the preamble, since it serves to focus the claimed invention, rather than presenting an obtusely-identified invention defined only by structural limitations.

Accordingly, the Sinanan reference fails to anticipate Claim 8 and should be allowable for this reason alone. It is respectfully requested that for these reasons alone, or in conjunction with the following arguments below, the rejection be withdrawn. Similarly, Claim 1, discussed *infra*, which also claims a “landscaping channel liner apparatus” is believed allowable over Sinanan for the same reasons discussed above.

iii. Sinanan does not teach or disclose “a selectively removable portion configured to receive a post.”

The Examiner implicitly concedes that Sinanan does not teach or disclose a selectively removable portion configured to receive a post affirmatively recited in Claim 8. The Examiner’s only argument in identifying corresponding structure is positing, hypothetically, that “a hole *could be* cut out of the bottom of the planter . . .” of Sinanan. In other words, the Examiner considers the “selectively removable portion” limitation a pseudo limitation that the prior art need not teach or disclose, yet still anticipate the claim. Sinanan must be modified to create the corresponding structure. There is no basis for this argument in either fact or law.

Factually, the “selectively removable portion” is an affirmative limitation. The Examiner is required to find the limitation in the prior art, not create it in the prior art. Again, the Examiner is reminded **that claim must be construed in light of the specification**. See MPEP § 2111, *In Re Johnston*, No. 05-1321 (Fed. Cir. Jan. 30, 2006), and *Phillips v. AWH Industries*, 415 F.3d 1303 (Fed Cir. 2005). An example of such a “selectively removable portion” is shown in Figs. 7 and 8 reproduced herein below⁵.

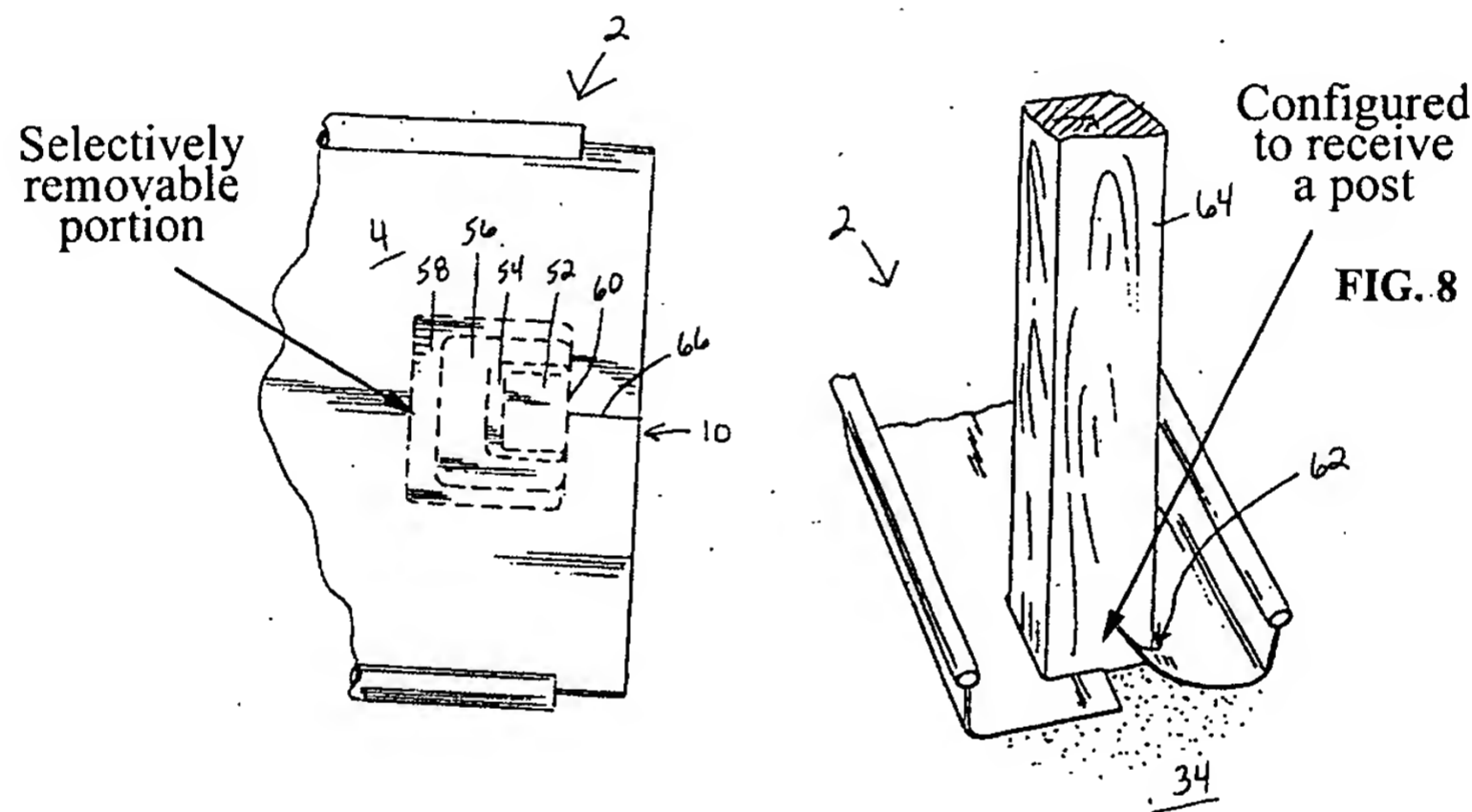


FIG. 7

Illustration 2: Figs. 7 and 8 of the present application demonstrate that a "selectively removable portion" exists in the specification and is not a hypothetical.

The figures show seams that define the portion of the channel liner clearly configured to be removed and accommodate a post. The “selectively removable portion” is, thus, not a hypothetical, it is a requirement in the claim. The Examiner cannot *modify* the reference by adding the missing limitation, and then argue the reference expressly or inherently anticipates the claim. If this were the standard, any prior art reference can be modified to anticipate any claim.

Furthermore, Sinanan teaches the precise antithesis of the Examiner’s allegation. Setting aside for a moment that “raised planter boxes” are not “landscaping channel liners,” the

⁵ What is shown is an illustrative embodiment, and not to be construed as limiting, pursuant footnote 2.

Examiner equates the claimed longitudinally-extending trough with the raised planter box 61 in Fig. 6 of Sinanan. Planter box 61 appears identical to planter boxes 3 and 4 of Fig. 1 sans the turned sides 63. Sinanan also discloses fence posts 27. However, Sinanan explicitly fails to disclose its fence posts 27 being received in planter boxes 3 and 4 by “removing” any “portion.” Rather, each post 27 is attached to a planter support 15. The annotated figures from Sinanan shown below demonstrates this point.

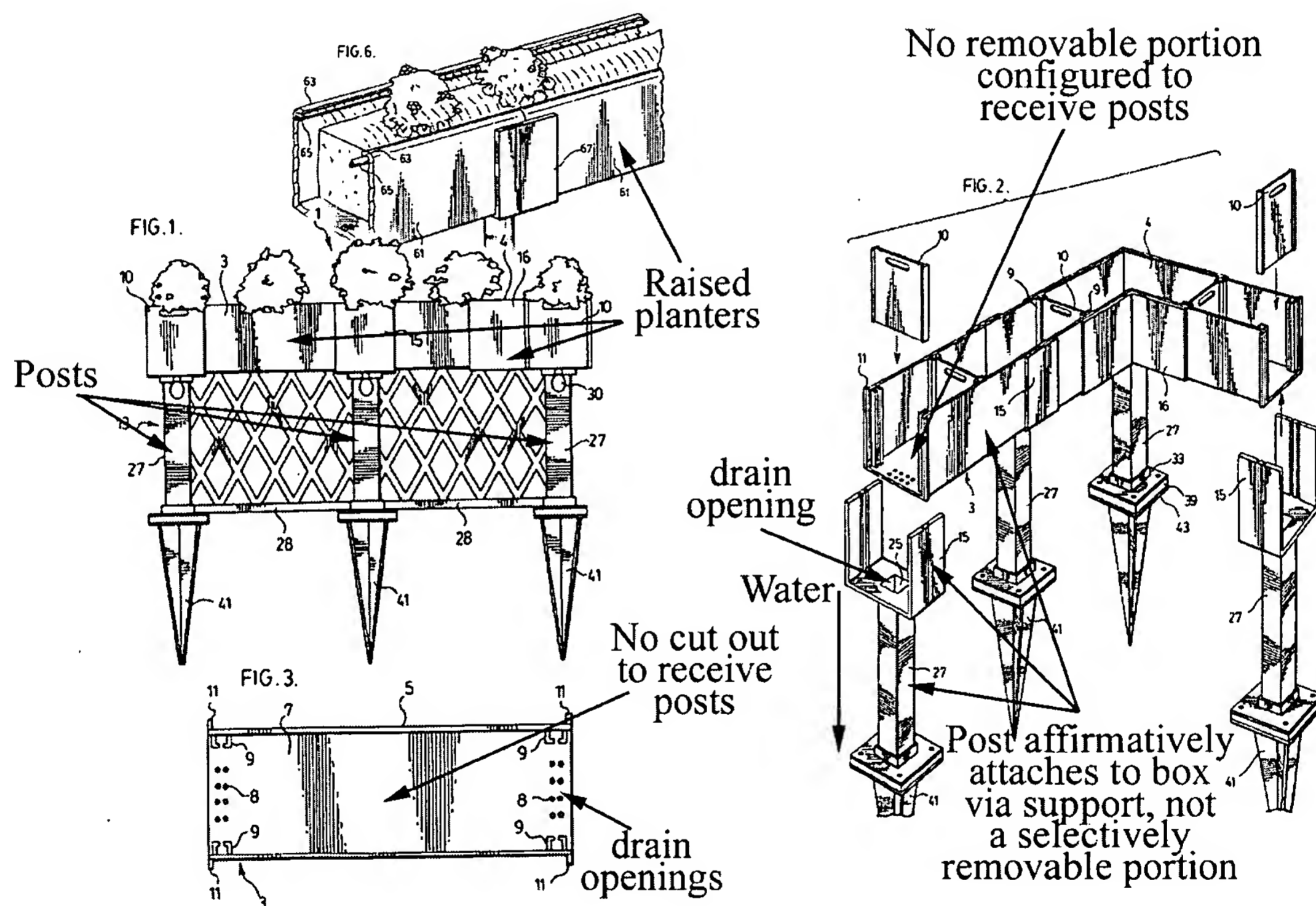


Illustration 3: Figs. 1, 2, 3 and 6 of Sinanan show planters and fence posts, but no “selectively removable portion.”

The Sinanan reference does not teach or disclose explicitly, inherently or by any other conceivable means the floor of the planter box being punched out to receive its fence post. Rather, the planter box is attached to the fence post by a different means as explicitly shown.

Fence posts 27 are attached to brackets 15 which attach boxes 3 and 4 together. Furthermore, drain holes 8 in box 3 (see Fig. 3) are needed for water to drain down post 27 via opening 25. (See, also, col. 4, lns. 40-50.) In fact, if a hole was made in planter box 3 (or 61 for that matter) to receive post 27, water could no longer exit box 3 and through post 27 as Sinanan explicitly teaches.

Finally, labeling the “removable portion” limitation of Claim 8 as merely a “broad recitation” does not give license to ignore the limitation or give it an “unreasonably broad” interpretation. Simply stereotyping the limitation in order to pigeon-hole an anticipation rejection is not reasonable, either in light of the specification pursuant MPEP § 2111⁶, or pursuant 35 U.S.C. § 102.

It is, therefore, respectfully asserted that Sinanan does not teach each and every limitation of Claim 8. Consequently, reconsideration is respectfully requested, and that this rejection be withdrawn and Claim 8 allowed. And because Claims 9-19 are dependent on Claim 8, they should be allowable as well.

iv. Sinanan does not anticipate Claim 11.

The Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 8 as discussed above, and Sinanan discloses that the floor comprises removable portions. With respect to the broad recitation that “the floor comprises removable portions”, the Examiner further alleges that Sinanan may have a portion removed from (such as by being cut out of) the floor. Therefore, as broadly recited, Sinanan is deemed to meet this recitation.

⁶ Again § 2111 requires “the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification.’” (emphasis added) See also *In re Johnston*, (Fed. Cir. 2006).

Here the Examiner continues the hypothetical that possibly portions of the floor of the raised planter could be removed “such as by being cut out.” For the reasons cited above, it is respectfully believed that this rejection is now moot, as the Sinanan reference makes no such disclosure. Accordingly, it is respectfully requested that this rejection be withdrawn and the Claim allowed.

v. Sinanan does not anticipate Claim 13.

The Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 8 as discussed above, and Sinanan discloses that the connector 65 interference fits in the receptacle 63.

The extent of the Examiner’s analysis is limited to asserting the “as broadly recited,” language. Again, this appears to be a substitute for identifying identical structure to the claim. In any event, Sinanan does not support the Examiner’s position, as illustrated in the annotated Figure 6 shown below.

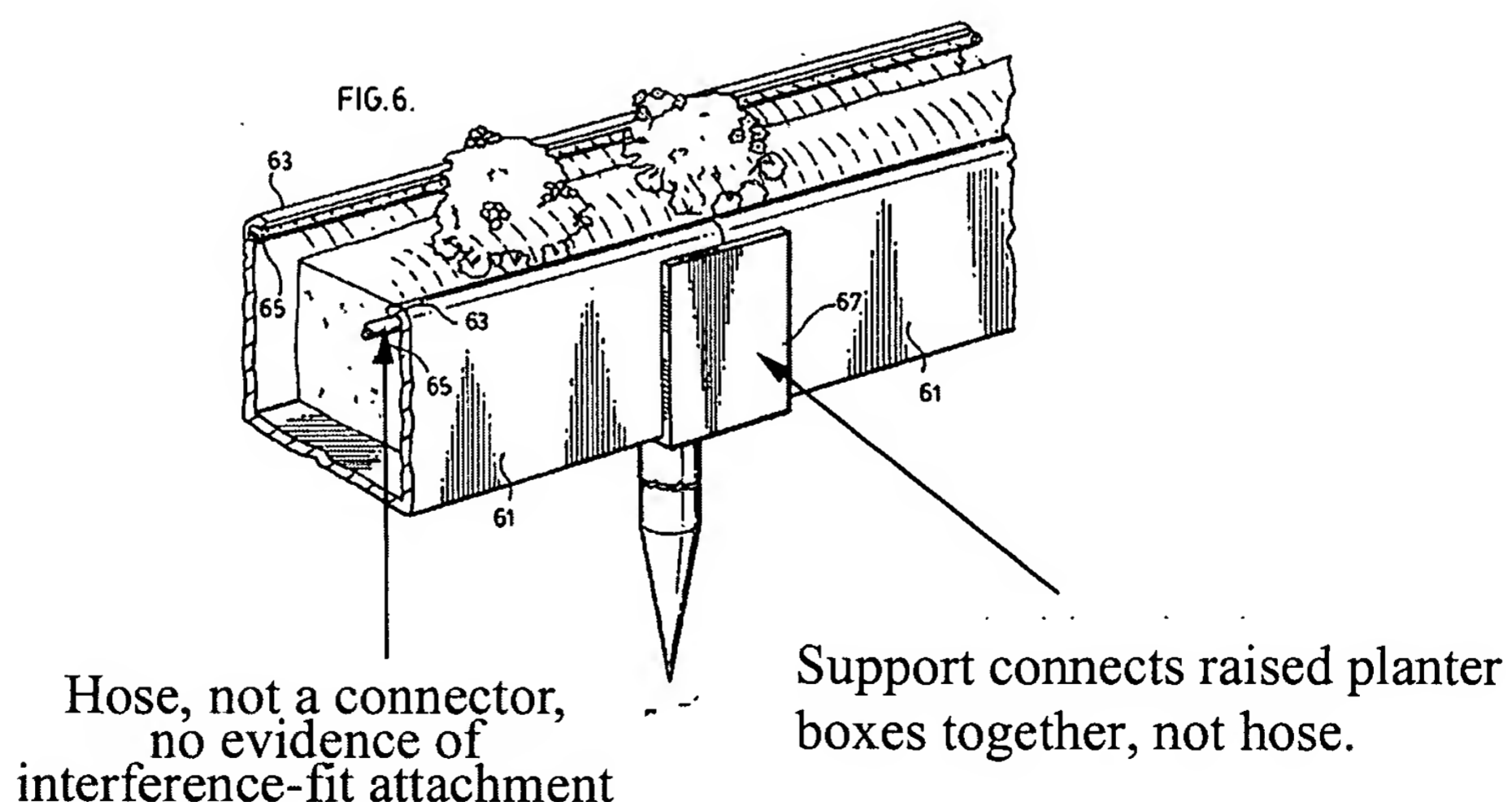


Illustration 4: Fig. 6 of Sinanan does not show a “connector” interference filling in a receptacle.

There is nothing in Sinanan disclosing that hose 65 is a “connector” that “interference fits” in the receptacle. The Examiner only speculates as to the mode of attachment, while pigeon-holing the rejection by asserting the “broadly recited” language. Again, this analysis appears to be a substitute for identifying a connector that interference fits in a receptacle, as required in the claim.

Accordingly, it is respectfully requested that this rejection be withdrawn.

vi. Sinanan does not anticipate Claim 16.

The Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 8 as discussed above, and discloses that the selectively removable portion is a plurality of selectively removable portions. With respect to “the selectively removable portion is a plurality of removable portions,” the Examiner alleges that this is a “broad recitation” and that Sinanan has a “plurality of removable portions” because at least two holes *could be* cut out of the bottom of the planter. The Examiner concludes that Sinanan is deemed to meet this recitation.

Again, the Examiner relies on modifying or changing Sinanan to include a limitation Sinanan does not otherwise disclose. To allege that “**at least two holes *could be* cut out of the bottom of the planter,**” fails to teach or disclose “a plurality of removable portions.” For the reasons previously discussed, this is not a reasonable interpretation of the claim. Accordingly, it is respectfully requested that this rejection be withdrawn.

B. Claims 1, 3-5 and 7 are not obvious under Sinanan in view of Ruen et al.

On pages 16-19 of the Official Action, the Examiner rejected Claims 1, 3-5, and 7 under 35 U.S.C. § 103(a) as being obvious under Sinanan in view of Reum et al. (U.S. Patent No. 4,761,923).

i. Legal standard to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art to modify or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (a reference is when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art and not based on Appellants disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), (See also MPEP § 2143.)

With respect to motivation, the prior art must suggest the desirability of the claimed invention, pursuant MPEP § 2143.01 Section I:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01 Section V. Also, the same is true if the combination of the prior art would change the

principle of operation of the prior art invention being modified. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01 § VI. Thus, the teachings of the references cannot be sufficient to render the claims *prima facie* obvious. *Id.*

With respect to the reasonable expectation of success requirement, some predictability is required to show such a reasonable expectation at the time the invention was made. See MPEP § 2143.02. In addition, evidence can be presented to support the position that no reasonable expectation of successes exists. *Id.*

With respect to teaching all of the claim limitations by the prior art, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), MPEP § 2143.03. Furthermore, all of the limitations of the claims must be considered and given weight. *Id.*

ii. The teachings of Sinanan and Reum fail to establish a *prima facie* case of obviousness against Claim 1.

The Examiner alleges that Sinanan discloses a landscaping channel liner apparatus (see Fig. 6) comprising: a longitudinally-extending trough 61 having a longitudinally-extending floor located between opposed longitudinally-extending sidewalls extending therefrom, and having first and second opposed transverse open ends formed from the floor and sidewalls; wherein each of the sidewalls defines a longitudinally-extending edge located opposite the longitudinally-extending floor; a longitudinally-extending receptacle 63 located on each longitudinally-extending edge, each receptacle 63 having first and second transverse open ends; wherein the first transverse open end of the longitudinally-extending receptacle 63 faces the second transverse open end of another longitudinally-extending receptacle 63; and wherein the first transverse open end of one longitudinally-extending receptacle 63 mates with the second transverse open end of the other longitudinally-extending receptacle 63, and the longitudinally-extending receptacles are essentially flush with each other.

The Examiner concedes that Sinanan fails to explicitly disclose that each of the longitudinally-extending sidewalls and floor extend longitudinally beyond the first transverse open end of each of the longitudinally-extending receptacles. However, the Examiner maintains that Reum et al. discloses a landscape edging apparatus 11 having sidewalls which each have a receptacle 14 on longitudinally-extending edges thereof wherein each of the longitudinally-extending sidewalls extend longitudinally beyond the first transverse open end of each of the longitudinally-extending receptacles (see Fig. 1). And the Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify the landscaping channel liner apparatus of Sinanan by substituting the overlapping sidewall, tubular rail 14, and connector 12 type of connection as taught by Reum et al. for the abutting sidewall, inwardly turned or rolled upper sidewall portion 63, hose-like conduit 65, and support bracket connection of Sinanan in order for the nested sidewalls to provide greater strength and less chance of separation at abutted seams. The Examiner further concedes that Reum et al. does not explicitly provide a teaching that the floor of Sinanan would extend longitudinally beyond the first transverse open end of each of the longitudinally-extending receptacles. However, according to the Examiner, if Sinanan were modified by Reum et al., so as to have longitudinally overlapping sidewalls, the floor of the landscaping channel liner apparatus of Sinanan would necessarily be overlapping in the same manner as the sidewalls.

Respectfully, it is believed that the rejection does not establish a *prima facie* case that Claim 1 is obvious under Sinanan in view of Reum et al. For example, with respect to motivation, the Examiner argues that Sinanan could be modified by replacing its rolled upper side wall portion 63 and water hose 65 with tubular rail 14 and connector 12 of Reum et al. “in order for the nested side walls to provide greater strength and less chance of separation and abutted seams” The Examiner, however, does not identify where in Reum et al. that the method of connecting structures would be superior to the bracket system 15 of Sinanan. A *prima facie* case of obviousness requires the Examiner to identify motivation, either explicitly or implicitly, in the references themselves or wherein the knowledge generally available to one of

ordinary skill in the art. Brackets 15 suspend planters 61 in the air. Whereas, Reum et al. are simply landscaping barriers placed in the ground that separate one area of ground from another. (See illustration 1, above.) Sinanan's brackets would need to be stronger to suspend the planters. There is nothing in Reum et al. identifying its connectors as providing "greater strength and less chance of separation at abutted seams" than brackets 15 of Sinanan. Such comparative analysis in the rejection is a fiction.

The proposed modification also renders Sinanan unsatisfactory for its intended purpose. As shown in Fig. 7 of Sinanan, conduits 65 are configured to spray water into the planter. (See, also, col. 4, lns. 56-64.) By disconnecting conduit 65 and replacing it with a connector that is not configured to spray water, that particular portion of the reference becomes unsatisfactory for its intended purpose, i.e. cannot spray water. The rolled-over portions 63 and conduits 65 are simply not intended to hold the planters. That is the function of support brackets 67 (like support bracket 15).

In addition, extending portions of the floor and side walls of planter 61 and removing the original support bracket 67 so the planters are held together via connectors and conduits, changes the principal operation of Sinanan. Brackets 67 are intended to connect, hold, and suspend the planter boxes off the ground, not the conduits or rolled-in portions. If the bracket portions 67 are no longer used to support the planters, then the principal operation of this disclosure is fundamentally changed. This is undeniable in view of the utility of the conduit 65 which is a water hose, not a support bracket. Thus, there is no suggestion or motivation to make the Examiner's proposed modification. Accordingly, the modifications cannot be sufficient to render the claims *prima facie* obvious.

This argument is also relevant to the reasonable expectation of success requirement. Making such fundamental modifications to Sinanan, by removing the bracket that suspends the entire planter system and the water conduit that drains the water, there can be no

reasonable expectation that such a design will succeed except through mere guessing or speculation. Nothing in either reference demonstrates that such a combination could be made and especially there is no expectation that the nested side walls would provide greater strength and less chance of separation than the structures already disclosed in Sinanan.

Lastly, the combination of the references do not teach all of the limitations of the claimed invention. It is conceded that Reum et al. does “not explicitly provide a teaching that the floor of Sinanan would extend longitudinally beyond the first transverse open end of each of the longitudinally-extending receptacle.” It cannot be said that a *prima facie* case of obviousness has been established, when it is conceded that not all of the limitations are taught by the combination of references. A leap of faith is made by asserting that if the sides were extended the floor would be extended as well. This is something neither reference teaches and can only be gleaned from the present application which is impermissible hindsight reconstruction. It is further notable that such modification would eliminate Sinanan’s ability to drain water through the holes located in the flooring of the planters, which are configured to drain through posts 27, as previously discussed. Therefore, such “overlapping,” as suggested by the Examiner, fails since it impermissibly changes the principal operation of Sinanan.

Accordingly, the combination of Sinanan and Ruen et al. fails to establish a *prima facie* case of obviousness. Applicants, therefore, respectfully request these rejections be withdrawn.

iii. The teachings of the Sinanan and Reum patents fail to establish a *prima facie* case of obviousness against Claims 3-5 and 7 as well.

As to Claim 3, the Examiner alleges that Sinanan in view of Reum et al. discloses the landscaping channel liner apparatus of Claim 1 as discussed above, and Sinanan in view of Reum et al. also discloses first and second connectors, wherein the first connector is partially fitted in the first transverse open end of the first longitudinally-extending receptacle and wherein

the second connector is partially fitted in the other of the longitudinally-extending receptacles through its first transverse open end.

In light of the arguments, *supra* at Section IV(B)(ii) this rejection is believed moot. Accordingly, it is respectfully requested that this rejection be withdrawn.

As to Claim 4, the Examiner alleges that Sinanan in view of Reum et al. discloses the landscaping channel liner apparatus of Claim 3 as discussed above, and Sinanan in view of Reum et al. also discloses that a portion of the first connector extends from the first transverse open end of one of the longitudinally-extending receptacles and is fitted into the second transverse open end of one of the longitudinally-extending receptacles of a second landscaping channel liner apparatus, and wherein a portion of the second connector extends from the first transverse open end of the other of the longitudinally-extending receptacles and is fitted into the other second transverse open end of the other of the longitudinally-extending receptacles of the second landscaping channel liner apparatus.

Again, it is respectfully believed that this rejection is now moot in light of the arguments made *supra*. Accordingly, it is respectfully requested that this rejection be withdrawn.

As to Claim 5, the Examiner alleges that Sinanan in view of Reum et al. discloses the landscaping channel liner apparatus of Claim 4 as discussed above, and Sinanan in view of Reum et al. also discloses the second transverse open end of the second landscaping channel liner apparatus is at least partially encompassed by a portion of the landscaping channel liner apparatus at the first transverse open end.

Again, it is respectfully believed that this rejection is now moot in light of the arguments made *supra*. Accordingly, it is respectfully requested that this rejection be withdrawn.

As to Claim 7, the Examiner alleges that Sinanan in view of Reum et al. discloses the landscaping channel liner apparatus of Claim 3 as discussed above, and Sinanan in view of Reum et al. also discloses that the first and second connector's interference fit in their respective longitudinally-extending receptacles.

Again, it is respectfully asserted that this rejection is now moot in light of the arguments made *supra*. Accordingly, it is respectfully requested that this rejection be withdrawn.

iv. The teachings of the Sinanan and Reum et al. patents fail to establish a *prima facie* case of obviousness against Claims 9 and 10 as well.

On pages 11 and 12 of the Official Action, the Examiner rejected Claims 9 and 10 under 35 U.S.C. § 103(a) as being obvious under Sinanan in view of Reum et al. As to Claim 9, the Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 8 as discussed above. However, the Examiner concedes that Sinanan fails to explicitly disclose that a receptacle from a second landscaping channel liner apparatus engages the connector by fitting between the longitudinally-extending edge and the connector. However, the Examiner further alleges that Reum et al. discloses a landscape edging apparatus 11 having sidewalls which each have a receptacle 14 on longitudinally-extending edges thereof wherein a receptacle 14 from a second landscaping channel liner apparatus 11 engages the connector 12 by fitting between the longitudinally-extending edge and the connector 12.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan by substituting the overlapping sidewall, tubular rail 14, and connector 12 type of connection as taught by Reum et al. for the abutting sidewall, inwardly turned or rolled upper sidewall portion 63, hose-like conduit 65, and support bracket connection of Sinanan in order for the nested sidewalls to provide greater strength and less chance of separation at abutted seams.

It is respectfully believed that the Examiner's argument here is substantively identical to the obviousness arguments made against Claim 1. Accordingly, all of the response arguments *supra* are incorporated herein in reply to this rejection. As a result, it is respectfully requested that this rejection be withdrawn.

As to claim 10, the Examiner asserts that Sinanan discloses the landscaping channel liner apparatus of Claim 8 as discussed above, but fails to explicitly disclose that the floor of a second landscaping channel liner apparatus overlaps a portion of the floor of the landscaping channel liner apparatus. The Examiner alleges, however, that Reum et al. discloses a landscape edging apparatus 11 having sidewalls which each have a receptacle 14 on longitudinally-extending edges thereof wherein the receptacle on one sidewall is shorter than the length of the sidewall so that sidewalls on adjacent landscape edging apparatus 11 overlap.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan by substituting the overlapping sidewall, tubular rail 14, and connector 12 type of connection as taught by Reum et al. for the abutting sidewall, inwardly turned or rolled upper sidewall portion 63, hose-like conduit 65, and support bracket connection of Sinanan in order for the nested sidewalls to provide greater strength and less chance of separation at abutted seams.

The Examiner further alleges that although Sinanan in view of Reum et al. does not explicitly provide a teaching that the floor of a second landscaping channel liner apparatus would overlap a portion of the floor of the landscaping channel liner apparatus, the Examiner notes that if Sinanan were modified by Reum et al. so as to have longitudinally overlapping sidewalls, the floor of the landscaping channel liner apparatus of Sinanan would necessarily be overlapping in the same manner as the sidewalls.

Again, it is respectfully believed that the Examiner's argument here is substantively identical to the obviousness arguments made against Claim 1. Accordingly, all of

the response arguments *supra* are incorporated herein in reply to this rejection. As a result, it is respectfully requested that this rejection be withdrawn.

v. The teachings of the Sinanan and Mason patents also fail to establish a *prima facie* case of obviousness against Claims 12, 15 and 17-19.

On pages 13-16 of the Official Action, the Examiner rejected Claims 12, 15, and 17-19 under 35 U.S.C. § 103(a) as being obvious under Sinanan (U.S. Patent No. 5,852,895) in view of Mason, III (U.S. Patent No. 5,379,558).

As to Claim 12, the Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 11 as discussed above. However, the Examiner concedes that Sinanan fails to explicitly disclose that the removable portions are perforated segments. The Examiner alleges that Mason, III, (see Figs. 4-5) discloses a ground covering mat 110 for ground anchored structures 112, wherein the mat 110 has selected scored portions 118 which are deemed to constitute perforated segments.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan by including selectively removable portions which are constituted by perforated segments as taught by Mason, III in order to be able to use the landscaping channel liner apparatus in a lawn or yard which has already pre-existing posts and other structure which would otherwise get in the way and prevent the laying the landscaping channel liners.

In light of the arguments made above evidencing that the Sinanan reference does, in fact, not disclose a “landscaping channel liner apparatus,” this rejection becomes irreconcilable. Essentially, the argument is that the hole that might hypothetically be punched in the raised planter of Sinanan suspended off the ground via post 27 is perforated so the planters can simultaneously be used “in a lawn or yard which has already pre-existing posts and other

structure which would otherwise get in the way and prevent the laying” of the planter. In other words, the Examiner argues that despite Sinanan showing a planter that already has posts that suspend the planter off the ground, the planter can also be in the ground to receive some undisclosed posts. Clearly these positions are irreconcilable. The invention of Sinanan is a “raised planter” (see title), meaning that it is specifically suspended off the ground. This modification destroys the principal operation of Sinanan, making it unsatisfactory for its intended purpose. Sinanan disclosing a “raised planter” means that it is not located “in a lawn or yard” as alleged. There is clearly no motivation to combine a “ground covering mat,” as disclosed in Mason, III with a “raised planter” disclosed in Sinanan. It is, thus, respectfully requested that this rejection be withdrawn.

As to Claim 15, the Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 8 as discussed above; however, Sinanan fails to explicitly disclose that the selectively removable portion is defined by at least one perforated seam. The Examiner further alleges that Mason, III (see Figs. 4-5) discloses a ground covering mat 110 for ground anchored structures 112, wherein the mat 110 has a score line 122 which is deemed to constitute at least one perforated seam.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan by including a selectively removable portion which includes a perforated seam as taught by Mason, III in order to be able to use the landscaping channel liner apparatus in a lawn or yard which has already pre-existing posts and other structure which would otherwise get in the way and prevent the laying the landscaping channel liners.

This rejection is respectfully believed substantively similar to the rejection made to Claim 12 above. Accordingly, all of the response arguments made *supra* are incorporated

herein in reply to this rejection. As a result, it is respectfully requested that this rejection also be withdrawn.

As to Claim 17, the Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 16 as discussed above; however, Sinanan fails to explicitly disclose that the plurality of selectively removable portions are each defined by at least one perforated seam. The Examiner contends that Mason, III (see Figs. 4-5) discloses a ground covering mat 110 for ground anchored structures 112, wherein the mat 110 has selected scored portions 118 and a score line 122 which are deemed to constitute a plurality of selectively removable portions which are each defined by at least one perforated seam (i.e., the score line 122).

The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan by including selectively removable portions which are constituted by perforated segments and a perforated seam as taught by Mason, III in order to be able to use the landscaping channel liner apparatus in a lawn or yard which has already pre-existing posts and other structure which would otherwise get in the way and prevent the laying the landscaping channel liners.

Again, it is respectfully believed that this rejection is substantively similar to those made with respect to Claims 12 and 15. Accordingly, all of the response arguments *supra* are incorporated herein and reply to this rejection. As a result, it is respectfully requested this rejection also be withdrawn.

As to Claim 18, the Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 16 as discussed above; however, Sinanan fails to explicitly disclose that the plurality of selectively removable portions share a common perforated seam. The Examiner further alleges that Mason, III (see Figs. 4-5) discloses a ground covering mat 110

for ground anchored structures 122 which are deemed to constitute perforated segments and a common perforated seam.

The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan by including selectively removable portions which are constituted by perforated segments and a common perforated seam as taught by Mason, III in order to be able to use the landscaping channel liner apparatus in a lawn or yard which has already pre-existing posts and other structure which would otherwise get in the way and prevent the laying the landscaping channel liners.

Again, it is respectfully believed that this rejection is substantively similar to those made with respect to Claims 12, 15 and 17. Accordingly, all of the response arguments *supra* are incorporated herein and reply to this rejection. As a result, it is respectfully requested this rejection also be withdrawn.

As to Claim 19, the Examiner alleges that Sinanan discloses the landscaping channel liner apparatus of Claim 8 as discussed above; however, Sinanan fails to explicitly disclose that the selectively removable portion comprises a seam extending therefrom to the periphery of the longitudinally-extending floor. The Examiner further alleges that Mason, III (see Figs. 4-5) discloses a ground covering mat 110 for ground anchored structures 112, wherein the mat 110 has selected scored portions 118 and a scored line 122 which are deemed to constitute the selectively removable portions and seam. The score line or seam 122 of Mason, III extends from the selectively removable portions or scored segments 118 to the periphery of the longitudinally-extending floor.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan by including selectively removable portions which are constituted by perforated

segments and a perforated seam as taught by Mason, III in order to be able to use the landscaping channel liner apparatus in a lawn or yard which has already pre-existing posts and other structure which would otherwise get in the way and prevent the laying the landscaping channel liners.

Again, it is respectfully believed that this rejection is substantively similar to those made with respect to Claims 12, 15, 17 and 18. Accordingly, all of the response arguments *supra* are incorporated herein and reply to this rejection. As a result, it is respectfully requested this rejection also be withdrawn.

On pages 19-20 of the Official Action, the Examiner rejected Claim 6 under 35 U.S.C. § 103(a) as being obvious under Sinanan in view of Reum et al., as applied to claims 1, 3, and 4 above, and further in view of Thomas (5,315,780).

The Examiner alleges that Sinanan in view of Reum et al. discloses the landscaping channel liner apparatus of Claim 4 as discussed above; however, Sinanan in view of Reum et al. fails to explicitly disclose spikes that extend from at least one of the sidewalls. The Examiner further alleges that Thomas discloses a lawn edging material anchoring arrangement wherein a landscape edging device has spikes (see Fig. 2) extending from at least one of the sidewalls.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the landscaping channel liner apparatus of Sinanan in view of Reum et al. to include spikes though the sidewall as taught by Thomas in order to provide surer anchoring of the channel liner apparatus to the ground.

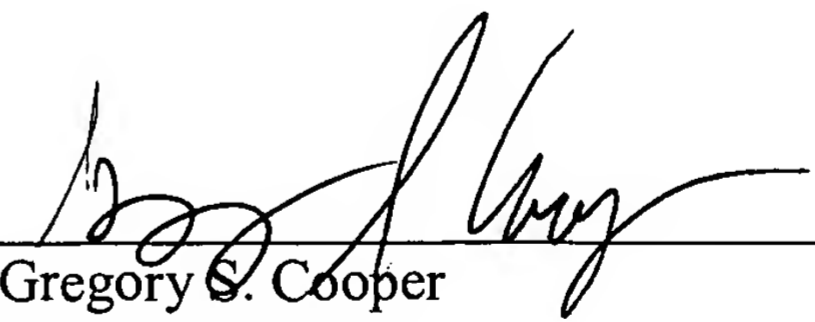
The arguments made *supra* in response to the Examiner's combination of Sinanan and Reum et al. with respect to Claim 1, as well as the other dependent claims, are incorporated herein in response to this rejection. Consequently, it is respectfully believed that this rejection is moot. In any event, it is also believed nonsensical. There is clearly no motivation to pierce the

walls of a planter structure that is sitting off the ground with a spike to anchor the planter sitting off of the ground into the ground. Again, this is irreconcilable. Moreover, making such a combination clearly alters the principal operation of all of the references, particularly Sinanan and Reum et al., as well as makes those references unsatisfactory for their intended purposes, for the reasons previously discussed in the prior rejection responses. It would furthermore appear to be hindsight reconstruction, since clearly the only reason such structures were combined was to reject the claims, since the combination is otherwise nonsensical and each do not provide any motivation to make the combination. Accordingly, it is respectfully requested that this rejection be withdrawn and the claims allowed.

If, upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact Applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. To the extent additional fees are required, please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 02-1010 (20794/82667) and please credit any excess fees to such deposit account.

Respectfully submitted,



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